

REMARKS

Favorable reconsideration and allowance of the present application are respectfully requested in view of the following remarks. Claims 1-14 are pending. Reconsideration of claims 1-14 is respectfully requested.

§ 103 REJECTIONS – LUMELSKY

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Lumelsky, et. al. (USP 6,516,350, hereinafter "Lumelsky"). Applicant respectfully traverses.

Because the rejection is based on 35 U.S.C. §103, what is in issue in such a rejection is "the invention as a whole", not just a few features of the claimed invention. Under 35 U.S.C. §103, " [a] patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." The determination under section 103 is whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. See In re O'Farrell, 853 F.2d 894, 902, 7 USPQ2d 1673, 1680 (Fed. Cir. 1988). In determining obviousness, the Examiner must explain what the differences between the claimed invention and the prior art are and provide objective factual evidence to support a conclusion that it would be obvious to one of

ordinary skill in the art to achieve the claimed invention, which includes those missing features.

In the second place, in rejecting claims under 35 U.S.C. §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the Examiner does not

make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

Claim 1 recites a combination of features including a capability negotiation step in which it is evaluated whether the server is to generate a new session to provide the multimedia service according to the request by the one client. The Office Action never mentions the word “new,” which is found in claims 1-8. This is improper because all words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424

F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). For this reason alone, the rejection of claims 1-8 is fundamentally improper and should be withdrawn.

The Office Action alleges that this claimed feature, minus the “new session” feature is “obvious in light of the teachings of Lumelsky as a means by which any client(s) on the network would have access to any network resource(s) on request per adaptive resource management. (Col. 5, lines 7-10).”

Applicant respectfully disagrees for the following reason. Col. 5, lines 7-10 of Lumelsky merely states a desired generic goal of Lumelsky’s invention, i.e., to provide a mechanism capable of providing an adaptive resource management function for distributed resources that is suited for the next generation of Internet.”

There is absolutely no mention in Lumelsky of evaluating whether the server is to generate a new session to provide a multimedia service from the server according to the request by the one client, as recited. In fact, the only mention of a “session” in Lumelsky is found in Col. 14, lines 49-54, which states that a final aspect of the invention is directed to a Resource management Framework (RMF) which is an extensible, distributed, policy-based, object-oriented management framework that supports per-flow media session setup and control between one or more media servers and end users and may augment the SCP. The RMF is disclosed in more detail in Serial No. 09/335,275, which is now U.S. Patent 6,529,950, which Lumelsky

incorporates by reference. Applicant has reviewed U.S. Patent 6,529,950 and cannot find anywhere in the '950 patent a disclosure or suggestion of the server generating a new session to provide a multimedia service from the server according to the request by the one client, as recited. In fact, the '950 patent is directed primarily to negotiated mapping sessions instead of to the claimed invention.

Merely that the prior art can be modified in the manner suggested by the Examiner does not render the modification obvious unless the prior art suggests the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-4 (Fed. Cir. 1992). Lumelsky contains no such suggestion and the Office Action fails to provide objective factual evidence of record of any such suggestion. It is well settled that a factual inquiry to modify a reference must be based on objective evidence of record, not merely on conclusionary statements of the Examiner. See, In re Lee, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). As Lumelsky fails to even suggest a capability negotiating step in which it is evaluated whether the server is to generate a new session to provide the multimedia service according to the request by the client, the motivation for modifying Lumelsky to include such a feature must be based on speculation and/or impermissible hindsight.

Similar comments apply to independent claim 4, which recites a combination of features including "the server for determining whether a new

session is to be generated to provide the multimedia service according to the request of the client.

Similar comments apply to independent claims 9 and 12. Claim 9 recites a combination of features including “generating a session between the server and the client when it is determined that sufficient resources are available to provide the requested multimedia service” and claim 12 recites a combination of features including “a session generator to generate a session between the server and the client when the determination part determines that sufficient resources are available to provide the requested multimedia service.” Lumelsky does not generate a session when the sufficient resource determination is made. Lumelsky merely provides information about the sufficiency of the resources. Lumelsky is merely a middleman and facilitator.

Accordingly, the Office Action fails to make out a *prima facie* case of proper motivation to modify Lumelsky to achieve the invention recited in independent claims 1 and 4, and the claims that depend from claim 1 or from claim 4, including the rejected dependent claims 2, 3, 5, 7 and 8, and/or to achieve the invention recited in independent claims 9 and 12, and the claims that depend from claim 9 or claim 12, including claims 10, 11, 13 and 14, and thus, fails to make out a *prima facie* case of obviousness of the claimed invention.

Accordingly, reconsideration and withdrawal of this rejection of claims 1-14 under 35 U.S.C. §103(a) as unpatentable over Lumelsky is respectfully requested.

CONCLUSION

All rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance. Should there be any outstanding matters that need to be resolved, the Examiner is respectfully requested to contact Robert J. Webster, Registration No. 46,472, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

BIRCH, STEWART, KOLASCH &, BIRCH, LLP

By:  #39,538

Scott L. Lowe
Reg. No. 41,458

JTE/RJW:lc/gf
0630-1203P

P.O. Box 747
Falls Church, VA 22040-0747
(703) 205-8000